

03/07/97

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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: K. SHIMOHIGASHI et al.  
Serial No.: 08/448,138  
Filed: May 23, 1995  
For: SEMICONDUCTOR MEMORY  
Group: 2511  
Examiner: T. Fears

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TERMINAL DISCLAIMER

Honorable Commissioner of  
Patents and Trademarks  
Washington, D.C. 20231

March 7, 1997

Sir:

Petitioner, Hitachi, Ltd., having its place of business at 6, Kanda Surugadai 4-chome, Chiyoda-ku, Tokyo 100, Japan, represents that it is the sole owner of the entire interest of U.S. Application Serial No. 08/448,138, filed May 23, 1995, for SEMICONDUCTOR MEMORY, and that the Assignment of all rights in connection therewith has been recorded at Reel 4277, Frame 685.

Petitioner hereby disclaims all that portion of the term of any patent to be issued on the above-identified application subsequent to the expiration date of the full statutory term, defined in U.S.C. 154 to 156 and 173, of U.S. Patent No. 5,448,520 issued September 5, 1995, and hereby agrees that any patent issued on the above-identified application shall be enforceable only for and during such time as the said U.S.

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Patent No. 5,448,520 and the above-identified application are commonly owned.

Petitioner, however, does not disclaim the terminal part of any patent granted on the instant application prior to the expiration date of the full statutory term, defined in 35 USC 154 to 156 and 173, of the above-listed U.S. Patent No.

5,448,520 in the event that U.S. Patent No. 5,448,520 expires; for failure to pay a maintenance fee; is held unenforceable; is found invalid; is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321; has all claims cancelled by a reexamination certificate; is reissued; or is otherwise terminated prior to the expiration of the above-referred-to full statutory term, except for the separation of legal title as stated above.

This disclaimer is to be binding with respect to any patent granted on the above-identified application, and is binding upon grantees, their successors, or assignees of any interests.

The undersigned is an attorney of record in this application and is empowered to act on behalf of Hitachi, Ltd. for execution and submission of Terminal Disclaimers, in accordance with the provisions of 37 CFR 1.321(b) and (c), effective January 4, 1994.

The undersigned hereby declares that all statements made herein of his own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are

punishable by fine, or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Respectfully submitted,

ANTONELLI, TERRY, STOUT & KRAUS LLP



\_\_\_\_\_  
Gregory E. Montone  
Registration No. 28,141

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**TERMINAL DISCLAIMER MEMO**

DATE: 3/25/97

APPL. S.N.: 08/448138

EXAMINER Leale

ART UNIT: 251

FROM: PARALEGAL GROUP 2500

SUBJECT: DECISION ON TERMINAL DISCLAIMER (T.D.) FILED 3/7/97

[  ] The T.D. is PROPER and has been recorded. (See 14.23)

[  ] The T.D. is NOT PROPER and has not been accepted for the reason(s) checked below (See 14.24):

- [  ] The recording fee of \$ \_\_\_\_\_ has not been submitted nor is there any authorization in the application file for the use of a deposit account. (See 14.25)
- [  ] The T.D. does not satisfy Rule 321(b)(3) in that the person who has signed the T.D. has not stated the extent of his/her interest (and/or the extent of interest of the business entity represented by the signature) in the application/patent. (See 14.27 & 14.26.1)
- [  ] The T.D. lacks the enforceable only during the common ownership clause - needed to overcome a double patenting rejection Rule 321(c). (See 14.27.1) See Attachment No. 1, paragraph 1.
- [  ] It is directed to a particular claim or claims, which is not acceptable since "the disclaimer must be of a terminal portion of the term of the entire patent to be granted." (MPEP 1490) (See 14.26, 14.26.2)
- [  ] The person who signed the T.D.:
  - [  ] has failed to state his/her capacity to sign for the business entity (See 14.28)
  - [  ] is not recognized as an officer of the assignee (See 14.29 and possibly 14.29.1) See attachment No. 1, paragraph 3.
- [  ] No documentary evidence of a chain of title from the original inventor(s) to assignee has been submitted, nor is there reel an frame number specified as to where such evidence is recorded in the Office. 37 CFR 3.73(b) See Attachment No. 3.
- [  ] No statement specifying that the evidentiary document have been reviewed and that, to the best of the assignee's knowledge and belief title is in the assignee seeking to take action. 37 CFR 3.73(b). See 1140 O.G. 72. See Attachment Nos. 2 & 3.
- [  ] The T.D. is not signed. (See 14.26, 14.26.3)
- [  ] The serial number of the application (or the number of the patent) which forms the basis for the double patenting rejection is missing or incorrect. (See 14.32)
- [  ] The serial number of this application being disclaimed is missing or incorrect. (See 14.26, 14.26.4 or 14.26.5)
- [  ] The period disclaimed is incorrect or not specified. (See 14.27, 14.27.2 or 14.27.3)
- [  ] Verified statement needed. See Attachment No. 1, paragraph 4.
- [  ] T.D. cannot obviate a rejection of double patenting under 35 USC 101. Only judicial (obviousness) double patenting can be obviated by a T.D.
- [  ] The T.D. date is earlier/latter than the true expiration date. The applicant may provide a substitute T.D.
- [  ] OTHER

DO NOT MAIL OR FAX THIS MEMO TO THE APPLICANT